

REMARKS**A. Claim Amendments Consistent With Specification**

In response to the Office Action, the specification and claims have been thoroughly reviewed. Independent claim 18 has been amended as have selected ones of its dependent claims. Further, new dependent claims 24 – 38 have been added. New method claims (independent claim 39 and dependent claims 40 – 52) have been added.

As will be discussed, Applicants submit the claims now distinguish over the cited art and address all objections of the Examiner for reasons that will be discussed.

In making the claim amendments, Applicant is mindful that claims need be supported by the specification. For the convenience of the Examiner, the following table correlates newly presented claim terms and features to the specification.

| Claim | Claim Term (Paraphrased) | Specification Page/Line | Remarks |
|--------|--|----------------------------|---|
| 18, 39 | Flexible, interconnected, elongated members | 12/22 | Strands are shown as long interconnected members Longitudinal axes |
| 19, 41 | Stainless steel | 13/9 | Stainless steel |
| 20 | Elongated members interwoven | 12/25 | Strands 21a, 21b interwoven |
| 21 | Different stretch properties in different axis | 12/28-30 | Different degree of stretch in response to a force dependent upon axis of force |
| 22 | Constrain lower portion | 10/6 | Constrain lower portion |
| 23 | Dimensioned to surround heart | 10/3-5 | Dimensioned to be slipped around heart |
| 24 | elongated members formed of a plurality of fibers | 12/20 | Fibers 20 formed into strands 21a, 21b |
| 25 | Open areas | 12/25 13/25 | Open cell Open areas |
| 26 | Lining | 14/13 | Anti-fibrosis lining |
| 27 | Anti-fibrosis | 14/13 | Anti-fibrosis lining |
| 28 | Coating on elongated members | 14/14 | Anti-fibrosis coating on fibers |
| 29 | Anti-fibrosis | 14/14 | Anti-fibrosis coating |
| 30, 47 | Surround valvular annulus | 10/18 | Assuring coverage of valvular annulus |
| 31, 48 | Surround ventricles | 10/8 | Cover lower ventricular extremities |

| | | | |
|--------|--|----------|---|
| | | 11/10 | Surround ventricles |
| 32, 49 | Surround atria | 10/12 | Cover upper portion |
| 33, 50 | Bent elongated members straightening as jacket expands | 13/3 | Construction results in expansion even though material of fibers may be non-expandable Bends in fibers shown in Fig. 6 Fibers described as non-expandable |
| 34, 40 | Metal alloy | 13/9 | Examiner will note stainless still is an allow |
| 35, 46 | Collapsible for minimally invasive placement | 14/18 | Passed through tube in minimally invasive procedure |
| 36 | Open apex | 11/5-8 | Open apex – Fig. 4 and 4A |
| 37 | Closed apex | 11/3 | Closed apex – fig. 3 and 3A |
| 38 | Maximum adjusted volume | 11/28 | Maximum adjusted volume |
| 42 | Placed on epicardium | 11/10 | Myocardium in direct opposition to jacket |
| 43 | Placed over pericardium | 14/13 | Over pericardium |
| 44 | Avoidance of impairment of cardiac function | 12/4 | Cardiac function not impaired |
| 45 | Low resistance to diastolic filling | 12/9-12 | Diastolic filling not impaired |
| 50, 52 | Attach to heart | 11/15-19 | Suture to heart |

B. Title of Application

In response to the Examiner's objection to the title, a new title is added to the application to correspond with the claim focus.

C. Priority Reference

The introductory paragraph of the specification is amended to update a claim to priority.

D. Rejections Based on 35 USC Sec. 101

The Examiner has rejected claim 23 on the basis that the claim purports to include a human body portion. Claim 23 is amended to recite the dimensions of the device and not to positively recite the combination of the jacket and the heart.

E. Rejections Based on 35 USC Sec. 102(b)

1. Apparatus Claims

The Examiner has rejected the claims based on U.S. Patent No. 5,224,363 to Sutton. Applicant has amended the claims in a manner believed to clearly distinguish over Shibamoto. Specifically, in claim 1, Applicant has amended the claim to recite that the jacket material is dimensioned so as to conform to the external geometry of the heart and surrounding at least the ventricles.

Applicant respectfully submits that reciting the sizing of a device with respect to human anatomy is of patentable distinction over the prior art. Sutton shows no such sizing.

In Ex parte Crigler, 125 USPQ 448 (PTO Bd. of App. 1959), the Board held, in a closely analogous case, claim language describing a size of a claimed element with reference to human anatomy was entitled to patentable weight. The Board reversed a final rejection and approved claim language stating "the adhesive on the surface is dimensioned so as to be attached by adhesion to continuous and spaced ear surfaces." 125 USPQ at p. 451 (emphasis added). The Board reasoned the quoted language "constitutes a structural limitation as to the size of the attaching means and therefore distinguishes from the [cited art]. Although the size of human ears varies, it is our opinion that neither [of the references] is dimensioned to fit on an ear and if either were made small enough to fit an ear, each would lose its usefulness for its disclosed purposes. 125 USPQ at p. 451 (emphasis added).

Sutton describes a metal glove for a hand. The glove has extending finger portions. There is nothing in Sutton regarding sizing of the glove and nothing to suggest modification of sizing to fit onto a human art in such a manner as to be snugly placed on the heart to treat cardiomyopathy in the manner described in the present invention.

With respect to claim 25 (open areas), Sutton describes a fluid impervious glove.

2. Method Claims

In addition to the foregoing, Applicant has submitted an independent method claim (Claim 29) incorporating the structure of claim 1 in a method for treating a heart disorder by taking the device of claim 1 and placing it on a human heart. Applicant respectfully submits

there is nothing in Sutton to suggest taking a device taught for receiving a human hand (a clearly non-sterile environment) and placing such a device on the human heart in the close confines of a patient's chest.

F. Double Patenting Rejection

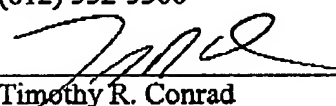
Applicants submit herewith a terminal disclaimer disclaiming the term of a patent issuing on this application to terminate with any patent issuing on commonly assigned and co-pending U.S. patent application Ser. No. 10/639,875.

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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